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EXAMINER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOANN RUVOLO and JAMES H. KAUFMAN

Appeal 2008-005522
Application 09/902,729¹
Technology Center 2100

Decided²: July 22, 2009

Before JOSEPH L. DIXON, JAY P. LUCAS, and JEAN R. HOMERE,
Administrative Patent Judges.

Lucas, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Application filed July 12, 2001. The real party in interest is International Business Machines Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 27 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to method and system for displaying information related to the sender of an electronic message automatically on receipt of that message. In the words of the Appellants:

One problem/pitfall associated with prior art PIM systems described above is the inability of such systems to automatically retrieve data from a database using an external trigger as opposed to an internal trigger. For example, when a primary user receives a call/message, it is sometimes necessary for the user to access, immediately, all the information relating to the caller/sender to efficiently handle the communication. In some cases, the primary user needs to be reminded of issues to be addressed, schedules to be reminded of or any relevant data in relation to the caller/sender. Therefore, what is needed is a communication triggered automatic retrieval of information related to a caller/sender.
(Spec 6, ll. 4 to 11)

The present invention describes a system and method for providing a primary user with information related to a source (transmitter) of a call/message based on entries stored in a personal information management (PIM) database. In the preferred embodiment, this information is provided upon the receipt of a communication and data available on the originator/transmitter of the call/message is displayed to the primary user. The system of the present invention identifies the caller/sender using an agent associated with the specific communication device/means, receiving the call/message, and retrieves associated entries in a database using the present invention's just-in-time-retrieval system that performs the task of locating and gathering information related to the caller/sender. This information is then summarized and

organized for display to the recipient on devices accessible by the user.
(Spec 7, ll. 1 to 11).

Claim 1 is exemplary:

1. A method for automatically retrieving and rendering information regarding a source of incoming communications, said method comprising a plurality of steps, one or more of said steps implemented locally or remotely, said method comprising:

a. receiving an incoming communication from a source intended for one or more recipients, said incoming communications comprising a plurality of communication types selected from the group: e-mail, telephone, fax, IM, collaborative message, or combination thereof;

b. detecting identity of said source;

c. retrieving from a database, data regarding said detected source, and extracting data comprising any of, or a combination of, the following information: to-do entries, future and past event entries, journal entries, and profile information;

d. summarizing said extracted data;

e. notifying said one or more recipients of said incoming communication, and

f. rendering said data in one or more electronic devices associated with said one or more recipients of said incoming communication.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Sandhu

US 6,347,307 B1

Feb. 12, 2002

Higgins	US 2002/0116,505 A1	Aug. 22, 2002
Bowman-Amuah	US 6,704,303 B1	Mar. 9, 2004
Shuman	US 6,708,202 B1	Mar. 16, 2004
Belfiore	US 6,990,513 B2	Jan. 24, 2006

REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1 to 4, 7 to 14, 18 to 23, and 27 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Shuman.

R2: Claims 5, 15 and 25 stand rejected under 35 U.S.C. 103(a) for being obvious over Shuman in view of Higgins.

R3: Claims 6 and 16 stand rejected under 35 U.S.C. 103(a) for being obvious over Shuman in view of Cortright.

R4: Claim 17 stands rejected under 35 U.S.C. 103(a) for being obvious over Shuman in view of Belfiore.

R5: Claim 24 stands rejected under 35 U.S.C. 103(a) for being obvious over Shuman in view of Bowman-Amuah.

R6: Claim 26 stands rejected under 35 U.S.C. 103(a) for being obvious over Shuman in view of Sandhu.

Groups of Claims:

The claims will be addressed in the order of the arguments. Claim 1 is representative.

See 37 CFR § 41.37 (c) (vii). *See also* In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (“If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground

of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.”).

Contentions

Appellants contend that the claimed subject matter is not anticipated by Shuman [R1], nor rendered obvious by Shuman in combination with the recited references of R2 through R6, because the references fail to teach the claimed limitations. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm the rejections.

ISSUE

The threshold issue before us is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a). In particular, the issue turns on whether each of the limitations of the claims can be found in Shuman.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a method and system for retrieving information about the sender of an electronic message, the convener of a meeting

request, the originator of a phone call, etc. automatically on receipt of the message, meeting request, call and so forth. (Spec 7, ll. 2-11). The user may also directly request this information. (Spec 10, l. 11). The background information on the sender/caller is retrieved from databases (e.g. #110, Fig. 1), summarized, and displayed to the user. (Spec. 11, ll. 1-3).

2. The reference patent to Shuman discloses a method and system for information derived from the sender of an electronic message, such as an incoming e-mail or calendar meeting request. (Col. 3, l. 64). Though the processing may be local on the user's hard drive, the data gathered for display may be on remote servers. (Col. 4, l. 50). The system detects the identity of the sender of the message (Col. 11, l. 28) from the message, and accesses related information from databases to supplement the message. (Col. 12, l. 55). For example, for an incoming calendar meeting request, the system interrogates the user's electronic calendar and indicates if the requested time slot is empty. (Id.). That information is displayed to the user along with the message.

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary

indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

This court has held in a number of decisions that a United States patent speaks for all it discloses as of its filing date, even when used in combination with other references. *In re Zenitz*, 333 F.2d 924, 925 (CCPA, 1964) (internal citations omitted).

However, although elements must be arranged as required by the claim, “this is not an *ipsissimis verbis* test [i.e., identity of terminology is not required].” *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990)(citing *Akzo N.V. v. United States Int’l Trade Comm’n*, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed.Cir.1986)).

ANALYSIS

From our review of the administrative record, we find that Examiner has presented a prima facie case for the rejections of Appellants’ claims under 35 U.S.C. §§ 102 and 103. The prima facie case is presented on pages

3 to 10 of the Examiner's Answer. In opposition, Appellants present a number of arguments.

*Arguments with respect to the rejection
of claims 1 to 4, 7 to 14, 18 to 23, and 27
under 35 U.S.C. § 102(e) [R1]*

Appellants contend that the Examiner erred in rejecting claims 1 to 4, 7 to 14, 18 to 23, and 27 under 35 U.S.C. § 102(e) for being anticipated by Shuman.

With regard to independent claims 1 and 10 (claim 1 will be representative), Appellants first argue that Shuman does not explicitly disclose an incoming communication. (Brief 9, middle). The Examiner has presented a number of examples of this incoming communication received in Shuman (Answer 12, top), and we see others (Col. 15, l. 59). Appellants' argument is untenable and not convincing of error.

Appellants next argue that Shuman does not teach or suggest a plurality of communications types other than e-mail. (Brief 9, bottom). Appellants' contention is not supported by the evidence before us, see FF#2 above (e-mail and calendar types are mentioned explicitly). In the Reply Brief Appellants argue that multiple mediums are used. (Reply 4, middle). In Shuman we find multiple media in the sense argued by Appellants: "which may be an e-mail message, meeting request, or other form of electronic communication." (Col. 11, l. 66 to col. 12, l. 1). We, thus, do not find error on this point.

Appellants next allege that the "system of Shuman does not appear to automatically identify the source of an incoming communication as recited

in the claims.” (Brief 10, middle). We find that Shuman does itemize the metadata that comes in with each e-mail, which includes a “From” field indicating the e-mail’s source. (Col. 11, l. 28), which allows the system to easily “detect the identity of said source” of the e-mail, as claimed.

Finally, Appellants allege that steps of claim 1 a. through d. are not performed before step e., notifying the recipient of the incoming message. (Brief 10, bottom). We agree with the Examiner that the sequence of steps is not required by the claim language or logic, as only the communication is stated to be noticed in step e. (Answer 14, middle). Thus the argument asserts a point not supported by the claim. We therefore find no error founding the Examiner’s position.

Appellants individually recite and argue the contents of claims 2, 3, 4, (7,11 and 19), (8-12), 14, (18, 20), 21, 22, and (23 and 27), in each case stating the limitation and alleging that it is not in the reference Shuman (Brief 11 to 14). We have reviewed each of these arguments, and the corresponding responses in the Examiner’s Answer (Answer 15 to 19). For each broad allegation of a missing limitation in the reference, the Examiner has presented (repeated) the portion of the reference relied upon. We do not find error in his application of the Shuman reference.

*Arguments with respect to the rejection
of claims 5,6,15,16,17, 24, 25 and 26
under 35 U.S.C. § 103 [R2-R6]*

In response to each of the rejections under 35 U.S.C. § 103 [R2 to R6], Appellants have uniformly pointed to the secondary reference and indicated that the teachings of the secondary reference do not remedy the

shortcomings of Shuman as applied to the claims in the rejection under 35 U.S.C. § 102. (Brief 14 to 17). We have analyzed the rejection of claims under 35 U.S.C. § 102 and have not found them to have the noted shortcomings. Thus, we do not find any error in the rejections R2 to R6 under 35 U.S.C. § 103(a).

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 27.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

PEB

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